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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,266	05/11/2006	Michael Mittelstein	NEOME-019A1US	3475
7590 09/30/2008				
Robert D Buyan Stout, Uxa, Buyan & Mullins 4 Venture Suite 300 Irvine, CA 92618				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3735				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,266

Applicant(s)

MITTELSTEIN ET AL.

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 2, 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) 35-51 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-34, 52 and 53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34, 52, and 53, drawn to a device for cutting or ablating tissue, classified in class 606, subclass 15.
- II. Claim 35-40, drawn to a method for manufacturing a device for cutting tissue, classified in class 72, subclass 370.1.
- III. Claims 41-51, drawn to A method for cutting or ablating a strip of tissue, classified in class 128, subclass 898.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another materially different process (MPEP § 806.05(f)). In the instant case the product can be made by welding a separate piece on the distal end to form the protector.

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(c)). In this case the device could be used to perform a materially different process, such as performing a biopsy.

Inventions II and III are unrelated.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a

serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

During a telephone conversation with Mr. Robert D. Buyan on September 23, 2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-34, 52, and 53. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35-51 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-31, 33, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is indefinite because exactly what is intended to be claimed by reciting "the protector is located on the portion of the inner tube that extends out beyond the end of the inner tube" is unclear. For the purposes of examination, this phrase will be interpreted as "...beyond the end of the outer tube" as that appears to be applicant's intent based on the disclosure related to figure 5.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7 and 20-22 lack an inventive step under PCT Article 33(3) as obvious over Baerveldt et al. Baerveldt et al provide the teachings set forth above. It would have been obvious to the artisan or ordinary skill to use polyimide for the insulator, to configure the cutter as two knife blades or two scissors, since these are recognized as equivalents in the art of eye surgery, thus producing a device such as claimed.

Claims 1-6, 9, and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wallace.

Wallace teaches a device which has an electrode within a tissue protecting sheath which is an insulator.

Claims 1, 13-15, 32, and 53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vassiliadis.

Vassiliadis et al teach a device which has an optical fiber within a tissue protecting sheath which is an insulator and transmits infra red radiation.

Claims 1, 13-15, 17, 18, 32, and 53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cook et al.

Cook et al teach a device which has an optical fiber within a tissue protecting sheath which is an insulator and transmits infra red radiation to produce ultrasound pulses.

Claims 24-26 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Eichenbaum.

Claims 33 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eichenbaum.

Claims 33 and 34 are product by process claims and re not structurally different from the device of Eichenbaum.

Claims 1-6, 8-19, 23, 32, 52, and 53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baerveldt et al.

Baerveldt et al teach a device which has either an optical fiber, a bipolar or monopolar electrode, a mechanical cutter, or an ultrasound device within a tissue protecting sheath which is an insulator and transmits energy to cut ocular tissue.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerveldt et al. Baerveldt et al provide the teachings set forth above. It would have been obvious to the artisan or ordinary skill to use polyimide for the insulator, to configure the cutter as two knife blades or two scissors, since these are recognized as equivalents in the art of eye surgery, thus producing a device such as claimed.

Claims 27 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerveldt et al in combination with Eichenbaum. Baerveldt et al provide the teachings set forth above as well as the equivalence of ultrasound, electrical energy, light, and mechanical force as an excision force. Eichenbaum teaches a device such as claimed except for the use of ultrasound, electrical energy, light, and mechanical force as an excision force. It would have been obvious to the artisan or ordinary skill to employ the various excision modalities of Baerveldt et al in the device of Eichenbaum, since these are recognized equivalents in the art, as taught by Baerveldt et al, thus producing a device such as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3735